

REMARKS/ARGUMENTS:

Claims 1, 3, 10, 11, and 17 have been amended. Claims 8 and 9 have been cancelled without prejudice. Claims 1 through 7 and 10 through 20 remain in the application.

Claim 3 was rejected under 35 USC §112, 2nd Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 10 was rejected for the same reason. Applicant has amended claims 3 and 10 to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Therefore, it is respectfully submitted that claims 3 and 10, as amended, overcome the rejection under 35 USC §112, 2nd Paragraph and are allowable over this rejection.

Claims 1 through 8 and 10 through 20 were rejected under 35 USC §103(a) as being unpatentable over Moss in view of Balaity. Claims 1 through 8 and 10 through 20 were also rejected under 35 USC §103(a) as being unpatentable over Balaity, et al., in view of Moss. Applicant respectfully traverses this rejection.

Independent claim 1 has been amended to include the allowable subject matter of claim 9. Therefore, the rejections under 35 USC §103(a) as to independent claim 1 and the claims dependent therefrom have become moot.

U.S. Patent No. 2,453,722 to Moss discloses a tool holder.

U.S. Patent No. 5,572,899 to Balaity, et al., discloses a bending method using cooperating jaws having angled planar faces.

In contradistinction, claim 11, as amended, claims an apparatus for deep rolling of an elongate work piece comprising a tool engageable in a seat wherein the tool comprising a rolling element and an extension extending from a lower end of the tool. The apparatus also includes a locking member mounted in the housing and reciprocal between a retracted position and an

extended position at which the member extends into a recessed region. Where upon placing the tool in the seat engages the member with the extension of the tool, removably securing the same in the housing.

Moss '722 alone or in combination with Balaity, et al. '899 does not disclose, teach, suggest or contemplate the present invention of claim 11, as amended. In particular, neither of the references disclose an apparatus for deep rolling of an elongate work piece wherein the apparatus comprises a tool engageable in a seat wherein the tool comprising a rolling element and an extension extending from a lower end of the tool. Furthermore, neither of the references discloses placing a tool in a seat that engages a locking member with the extension of the tool, therefore removably securing the tool in the housing. The Moss reference only discloses a first and second block 12, 13 adapted to carry tools 14, 15. While the Balaity, et al. reference only discloses a device for bending a plate with an offset distance L and two angles simultaneously. The Balaity device has special jaws which are replacably attachable to the jaws of pliers. Nowhere is it contemplated, suggested or taught in either reference to use these devices as an apparatus for deep rolling an elongate work piece with the limitations as described above. In fact, none of the references cited or any of the prior art cited in the present action disclose an apparatus for deep rolling of an elongate work piece as claimed by Applicant. Specifically, none of the references cited teach, suggest or anticipate a tool engageable in a seat of a housing wherein the tool comprises a rolling element and an extension extending from a lower end of the tool wherein the tool is placed in a seat of the housing of the deep rolling apparatus such that the tool engages at its extension a locking member to removably secure the tool in the housing. A combination of Moss and Balaity, et al., could not result in an apparatus for deep rolling an elongate work piece having a tool and locking member with limitations as described above. If

there is no disclosure of such limitations and no teaching or suggestions to do such in the references, these limitations cannot be inferred into a combination of the prior art references.

Hence, any combination of these references could not create the apparatus for deep rolling an elongate work piece as claimed in Applicant's claim 11, as amended. Any attempt to change the Balaity, et al. or Moss references into an apparatus for deep rolling an elongate work piece is not possible and any attempt would result in failure of the mechanism as disclosed in Moss and Balaity, et al. Therefore, a combination of Moss and Balaity, et al., references could not result in Applicant's invention as claimed in claim 11, as amended. Since there is absolutely no teaching in any of the references to be combined to create an apparatus for deep rolling of an elongate work piece, any attempted combination of these references to derive Applicant's invention can only be made in hindsight after reviewing Applicant's invention. The novel ideas of the Applicant's invention cannot be inferred or inserted from another reference into the Moss or Balaity, et al., references unless there is a specific teaching or suggestion for such within the prior art. Hence, these references by law cannot be combined to result in Applicant's apparatus for deep rolling an elongate work piece as claimed in claim 11, as amended. Any such attempt to combine Moss and Balaity, et al., can only result in a tool holder having cooperating jaws having angled planar faces to bend metals. Therefore, it is respectfully submitted that claim 11, as amended, and the claims dependent therefrom, overcome the rejection under 35 USC §103(a) and are allowable over this rejection.

Independent claim 17 in contradistinction claims a deep rolling apparatus comprising an upper tool, having a rolling element for engagement with a work piece and a lower tool housing defining at least one substantially rectangular seat. The deep rolling apparatus also comprises a lower tool positionable in the seat, wherein the lower tool comprises a rolling element. A detent

comprising a member movable between a first position at which it locks the tool in the seat and a second position at which the tool is removable from the seat.

Moss '722 alone or in combination with Balaity, et al., '899 does not disclose, teach, suggest or contemplate the present invention as claimed in claim 17, as amended. In particular, neither of the references disclose a deep rolling apparatus comprising an upper tool comprising a rolling element for engagement with a work piece and a lower tool housing defining at least one substantially rectangular seat. As neither of the references disclose any of these limitations a combination of such references cannot and would not result in a deep rolling apparatus as claimed by Applicant in claim 17. Neither of the references disclose any upper tool comprising a rolling element for engagement with the work piece and a lower tool housing defining at least one substantially rectangular seat. Wherein these upper tools and lower tools are used for deep rolling. Neither reference describes any type of seat that is substantially rectangular and arranged within a lower tool housing. Hence, if there is no disclosure of such limitations and no teaching or suggestion to do such in the references, these limitations cannot be inferred into a combination of these two references. Therefore, any combination of these references could not create the deep rolling apparatus as claimed in Applicant's claim 17, as amended. Any attempt to change the Moss or Balaity reference into a deep rolling apparatus is not possible and any attempt would result in failure of the mechanism as disclosed in the Moss or Balaity references. Hence, since there is absolutely no teaching in either of the references to be combined with one another to create a deep rolling apparatus any attempt to combine these references to derive Applicant's invention can only be made in hindsight after first reviewing the Applicant's invention. Such teaching or suggestion cannot be inferred or inserted from another reference or by stating that it would be obvious to one skilled in the art. If this were such an obvious step,

then it would have been taught, suggested or disclosed somewhere in the prior art. Therefore, it is respectfully submitted that claim 17, as amended, and the claims dependent therefrom, overcome the rejection under 35 USC §103(a) and are allowable over this rejection.

Claim 9 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Applicant has amended claim 1 to include the allowable subject matter for claim 9 and therefore, claim 1 and the claims dependent therefrom are now allowable.

If the Applicant can be of any further assistance or provide any other information in the prosecution of this application, the Examiner is requested to contact the undersigned at (248) 364-2100.

Respectfully submitted,

RAGGIO & DINNIN, P.C.

By: _____

Michael T. Raggio (Reg. No. 36,645)
2701 Cambridge Court, Ste. 410
Auburn Hills, MI 48326
(248) 364-2100

Attorney for Applicant

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